

09 AUG 2000



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Patent Cooperation Treaty
Legal Office

Address: Assistant Commissioner for Patents
Box PCT
Washington, D.C. 20231

Mr. Joseph S. Tripoli
THOMSON MULTIMEDIA LICENSING, INC.
PO Box 5312
Two Independence Way
Princeton, New Jersey 08543

In re Application of	:	
EBLING, Mark, Jacob, et al.	:	
U.S. Application No.: 09/529,184	:	
PCT No.: PCT/US98/21556	:	DECISION ON
International Filing Date: 13 October 1998	:	PETITION UNDER 37
Priority Date: 14 October 1997	:	CFR 1.47(a)
Attorney's Docket No.: RCA 88759	:	
For: SYSTEM FOR FORMATTING AND PROCESSING	:	
MULTIMEDIA PROGRAM DATA AND	:	
PROGRAM GUIDE INFORMATION	:	

This decision is issued in response to the "Communication Pursuant To PCT Rule 4.15(b)" filed 07 April 2000 and the concurrent submission of a declaration which was not executed by one of the applicant/co-inventors, Mehmet Kemal Ozkan, which together have been treated as a petition under 37 CFR 1.47(a) seeking acceptance of the national stage application without Mr. Ozkan's signature. Deposit Account No. 07-0832 has been charged the required \$130 petition fee.

BACKGROUND

On 13 October 1998, applicants filed international application PCT/US98/21556 which claimed a priority date of 14 October 1997 and which designated the United States.

On 21 April 1999, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of 19 months from the priority date. As a result, the deadline for submission of a copy of the international application (unless previously communicated by the International Bureau) and payment of the basic national fee was extended to expire 30 months from the priority date, i.e., 14 April 2000.

On 07 April 2000, applicants filed a transmittal letter for entry into the national stage in the United States which included an authorization to charge Deposit Account No. 07-0832 \$1,982 (\$970 for the basic national fee, \$504 for inclusion of 28 extra total claims, \$468 for inclusion of 6 extra independent claims, and \$40 for recordation of an assignment). The

transmittal letter was also accompanied by a declaration executed by five of the six inventors (the nonsigning inventor was Mr. Mehmet Kemal Ozkan) and the "Communication Pursuant To PCT Rule 4.15(b)" considered herein. This Communication asserts that Mr. Ozkan's signature could not be obtained because he could not be located.

DISCUSSION

In order for the application to be accepted without the signature of the nonsigning inventor, applicants must submit a grantable petition under 37 CFR 1.47(a). A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(I), (2) a statement of the last known address of the inventor; (3) an oath or declaration executed by the other inventors on their own behalf and on behalf of the non-signing inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Here, the submission included an authorization to charge Deposit Account No. 07-0832 for "any additional fees which may be required." Based on this authorization, Deposit Account No. 07-0832 has been charged \$130 as the petition fee. Item (1) is therefore satisfied.

The Communication sets forth the nonsigning inventor's last known address, so item (2) is satisfied.

With respect to item (3), applicants section 409.03(a) of the Manual of Patent Examining Procedure ("MPEP") states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Here, the declaration submitted contains an unsigned signature block for the nonsigning inventor and it is executed by the other five inventors. Thus, item (3) is satisfied.

Regarding item (4), the proof required to show that a nonsigning inventor cannot be reached after diligent effort is set forth in section 409.03(d) of the MPEP, which states:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. ...

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

Here, the evidence describing the search for Mr. Ozkan is contained in the Communication, which states that the application materials were sent by DHL Worldwide Express to the nonsigning inventor's last known address and that the inventor could not be located at that address. This is supported by the accompanying documentation. However, a single mailing to the last known address of an inventor does not constitute a "diligent effort" to reach an inventor for purposes of 37 CFR 1.47(a). Applicants must provide evidence of any additional efforts made to reach Mr. Ozkan in the form required by the MPEP (that is, in an affidavit or declaration from a person with firsthand knowledge of the facts set forth).

Based on the foregoing, it is concluded that the petition in its present form does not provide sufficient proof that the missing inventor, Mr. Ozkan, cannot be reached after diligent effort. As this is one of the requirements for a successful petition under 37 CFR 1.47(a), the instant petition must be denied.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Failure to file a timely response will result in abandonment of the application.


Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the International Division, Legal Staff.



Richard Cole
PCT Legal Examiner
PCT Legal Office

RMR/RC:rmr



Richard M. Ross
PCT Petitions Attorney
PCT Legal Office

Telephone: (703) 308-6155

Facsimile: (703) 308-6459